

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 03-767)

Appl. No. : 10/634,415 Confirmation No. 7943
Applicant : Ryan J. Highland
Filed : 08/05/2003
Art Unit : 3691
Examiner : Virpi H. Kanervo

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Dear Sir:

Applicant requests reconsideration of patent term adjustment in light of the *Wyeth v. Dudas* decision (D.D.C., Memorandum Opinion for Case No. 07-1492, Sept. 30, 2008).

Applicant agrees with the Office's Patent Term Adjustment of A delay minus Applicant Delay of 1,064 days. Based on a June 9, 2008 date for filing an RCE, Applicant submits the B delay is 673 days. After taking A delay and B delay overlap into account, Applicant requests reconsideration of Patent Term Adjustment to **1,343** days total.

Please charge any underpayment or credit any overpayment related to this request to Deposit Account No. 13-2490.

A. Definition of A Delay and B Delay

According to *Wyeth*, there are three guarantees of patent term under 35 U.S.C. § 154(b). The first, termed “A delay”, are extensions due to delays by the PTO beyond statutory deadlines, such as fourteen months for a first response on the merits, four months to issue an office action after a response, and four months to issue a patent after the fee is paid. *Wyeth*, p. 3. The second, termed “B delay”, is a “a one-day term extension [that] is granted for every day greater than three years after the filing date that it takes for the patent to issue, **regardless of whether the delay is the fault of the PTO**” *Id.* (emphasis added). The third, termed “C delays”, concerning delays due to interferences, secrecy delays and appeals was not substantively addressed by *Wyeth. Id.*

35 U.S.C. § 154 also reduces patent term adjustment due to delays by the applicant for the period of time where an applicant failed to engage in reasonable efforts to conclude prosecution of the application. 35 U.S.C. § 154(b)(2)(C)(i). Specifically, the statute defines failing to engage in reasonable efforts to conclude prosecution for any periods of time “in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.” 35 U.S.C. § 154(b)(2)(C)(ii). For purposes of this request, A delay includes reduction in patent term due to delays by the Applicant.

B. Application Summary

The total patent term adjustment indicated on the Determination of Patent Term Adjustment for this application is 1,064 days. Key dates in this application are in the table below.

Date	Activity	A Delay	B Delay	Applicant Delay
August 5, 2003	Application Filed			
October 5, 2004	14-month Date After Filing	+		
August 5, 2006	3-Year Date After Filing	+	+	
September 4, 2007	First Non-Final Rejection Mailed	+	+	
December 4, 2007	Response to First Non-Final Rejection Filed		+	
March 10, 2008	First Final Rejection Mailed		+	
May 12, 2008	First Response After Final Filed		+	
May 23, 2008	Advisory Action Mailed		+	
June 9, 2008	First Request for Continued Examination (RCE) Filed		+	
July 9, 2008	Second Non-Final Rejection Mailed			
October 8, 2008	Response to Second Non-Final Rejection Filed			
December 24, 2008	Second Final Rejection Mailed			
March 1, 2009	Second RCE Filed			
May 11, 2009	Third Non-Final Rejection Mailed			
July 27, 2009	Response to Third Non-Final Rejection Filed			
November 23, 2009	Notice of Allowance Mailed			
December 23, 2009	Issue Fee Paid			

A “+” in the A Delay, B Delay, or Applicant Delay column in the table above indicates the Applicant believes the respective delay accrues between consecutive dates with “+” signs. For example, as shown in the table above, Applicant believes that A delay was accrued between October 5, 2004 and September 4, 2007.

C. Calculation of A Delay and Applicant Delay

For the A delay and Applicant delay calculations, the Patent Term Adjustments (PTA) on PAIR for this application indicate a total of 1,064 days, including:

An A delay period or “A period” of 1,064 days from October 5, 2004, the 14-month date after filing, to September 4, 2007, the mailing date of the First Non-Final Rejection. The First Non-Final Rejection was the first action on the merits. Applicant agrees with the determination.

There is no Applicant delay recorded on PAIR for the instant application. Applicant agrees with this determination.

Therefore, Applicant agrees with the Office that the A delay minus Applicant delay is 1,064 days.

D. B Delay Calculation

The application was filed on August 5, 2003. The three year date after filing is August 5, 2006. Therefore, Applicant submits the B delay period or “B period” is the time from the day after the 3 year anniversary (or August 6, 2006) until either a patent issues for the application, an RCE is filed for the application, or for other reasons that are not applicable to this application (*e.g.*, interferences and Applicant-requested delays). *See* 35 U.S.C. § 154(b)(1). Specifically, the First RCE was filed for this application on June 9, 2008. Applicant therefore submits the B delay period is the time from August 6, 2006 to June 9, 2008 for a total of 673 days.

E. Requested Patent Term Adjustment

The *Wyeth* decision states that “the ‘A period’ and ‘B period’ overlap only if they occur on the same calendar day or days.” *Wyeth*, p. 8. Thus, according to the *Wyeth* decision, Patentees are entitled to both the A delay” and the actual B delay minus any overlap which occurs on the same calendar days. As indicated in the table above, there is an overlap of 394 days between the A period and the B period during the interval of August 6, 2005 and September

4, 2007. Thus, the total Patent Term Adjustment due to both the “A” and “B” delays minus the overlap and Applicant delay is $1,064+673-394 = \underline{1,343}$ days.

Therefore Applicant respectfully requests that the estimated Patent Term Adjustment for this case **should be increased from 1,064 days to 1,343 days.**

If a telephone conference would expedite the prosecution of this Request for Reconsideration of Patent Term Adjustment, please contact the undersigned attorney at (312) 913-0001.

Respectfully submitted,

**McDonnell Boehnen
Hulbert & Berghoff LLP**

Date: December 23, 2009

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